

REMARKS

This paper is a complete and timely response to the Office Action (Final) mailed September 22, 2004. Claims 2 - 22 and 25 - 30 remain pending. Reconsideration and allowance of the application and presently pending claims are respectfully requested.

Applicants respectfully submit that the proposed combination of *Flowers* in view of *Ying* does not disclose, teach, or suggest all claim limitations. Consequently, the proposed combination fails to establish a *prima facie* case of obviousness. Accordingly, the rejection of claims 2 – 22 and 25 – 30 should be withdrawn.

In this regard, the Office's analysis is not in accordance with 35 U.S.C. §103. The Office alleges that Applicants' specification provides a non-limiting description of "performance gain" as an increase in performance. The Office concludes that a reference (*i.e.*, *Ying*) that includes a "performance gain" in combination with *Flowers* is sufficient to render Applicants' claimed system and methods obvious. Applicants respectfully disagree and request that the Office reconsider the rejection in light of the entirety of Applicants' claims. The Office's interpretation of "performance gain" fails to give a complete construction of Applicants' claims. This incomplete construction of Applicants' claims leads to a failure to consider features required by the Applicants' claims that are absent from the cited prior art.

Response to 35 U.S.C. §103 Rejections – Claims 2 – 22 and 25 - 30

A. Statement of the Rejection

The Office Action indicates that claims 2 - 22 and 25 - 30 presently stand rejected under 35 U.S.C. §103(a) as allegedly being unpatentable over U.S. Patent Number 5,533,174 to *Flowers et al.* ("*Flowers*") in view of International Publication Number WO 01/18681 A2 to *Ying et al.* ("*Ying*.")

B. Discussion of the Rejection

To establish a *prima facie* case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations. The teaching or suggestion to make the

claimed combination and the reasonable expectation of success must both be found in the prior art and not based on applicant's disclosure. *In re Vaeck*, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991).

In order for a claim to be properly rejected under 35 U.S.C. §103, the combined teachings of the prior art references must suggest all features of the claimed invention to one of ordinary skill in the art. See, e.g., *In Re Dow Chemical*, 5 U.S.P.Q.2d 1529, 1531 (Fed. Cir. 1988), and *In re Keller*, 208 U.S.P.Q.2d 871, 881 (C.C.P.A. 1981).

Applicants respectfully traverse the rejection of claims 2 - 22 and 25 - 30 for at least the reason that the cited references fail to disclose, teach, or suggest each element and/or feature recited in the claims. Applicants respectfully request that the Office reconsider the rejection.

For example, Applicants' independent claim 7 includes "displaying potential estimated performance gains that may result from the purchase of a set of fonts other than the set of fonts requested by the visitor, ***wherein potential estimated performance gains comprise a characteristic of a print job executed with a print device installed font.***" The proposed combination of *Flowers* and *Ying* does not disclose, teach, or suggest at least the emphasized limitation of claim 7. Specifically, neither *Flowers* nor *Ying* disclose, teach, or suggest "***potential estimated performance gains comprise a characteristic of a print job executed with a print device installed font.***"

Ying apparently discloses (FIGs. 68 and 71 - 74) a graphical user interface associated with a browser (*i.e.*, Netscape) that shows a "best match" score associated with a plurality of available fonts. The best match score compares attributes of a sample portion of text provided by a visitor to the Web site with attributes associated with each of the available fonts. *Ying* further describes displaying sample text on a test drive web page using a user-selected font selected from the available fonts. Graphically presenting a score associated with a comparison of font attributes and presenting sample text rendered on a display with a user selected font does not disclose, teach, or suggest Applicant's claimed feature that defines "***potential estimated performance gains***" as a "***characteristic of a print job executed with a print device installed font.***" Graphically presenting the result of a font comparison analysis does not suggest a potential estimated performance gain associated with a print job executed with a print device installed font. Rendering sample text on a display device also does not suggest a potential estimated performance gain associated with a print job executed with a print device installed font.

For at least these reasons, the proposed combination fails to disclose, teach, or suggest each method limitation recited in Applicants' claimed invention. Thus, the proposed combination fails to establish a *prima facie* case of obviousness for claim 7.

In this regard, the Office's analysis is not in accordance with 35 U.S.C. §103. The Office alleges that Applicants' specification provides a non-limiting description of "performance gain" as an increase in performance. The Office further alleges, "In the method disclosed by *Ying*, the performance gain relates to an abstract increase in a user's visual satisfaction between the comparisons of two or more different font families." The Office concludes that since *Ying* includes a teaching of a "performance gain," the proposed combination renders Applicants' claimed method obvious. Applicants disagree. This incomplete construction of Applicants' claims leads to a failure to consider features required by the Applicants' claims that are absent from the cited prior art. Missing from *Ying* and *Flowers* is a teaching of Applicants' claimed "***potential estimated performance gains***," which are "***characteristic of a print job executed with a print device installed font***." Because *Ying* and *Flowers* do not disclose, teach, or suggest that potential estimated performance gains are characteristics of a print job executed with a print device installed font, Applicants' independent claim 7 is allowable.

Because independent claim 7 is allowable, as discussed above, dependent claims 2 - 6, 8 - 15, and 28, which depend either directly or indirectly from independent claim 7, are also allowable. See *In re Fine*, 837, F.2d 1071, 5 U.S.P.Q.2d 1596, 1598 (Fed. Cir. 1988). Accordingly, Applicants respectfully request that the rejection of claims 2 - 15 and 28 be withdrawn.

Applicants' independent claim 16 is directed to a method for distributing print device fonts. The claim includes "displaying potential estimated performance gains, based upon the visitor's system configuration, resulting from installation of one or more fonts other than the one or more of the fonts designated, ***wherein potential estimated performance gains comprise a characteristic of a print job***," and "in response to a purchase by the visitor, ***installing said selected one or more of the fonts on a print device of the visitor***."

Applicants respectfully submit that the proposed combination of *Flowers* in view of *Ying* does not render Applicants' claimed method for distributing print device fonts obvious for at least the reason that neither *Flowers* nor *Ying* disclose, teach, or suggest at least the emphasized limitations of claim 16. Specifically, neither *Flowers* nor *Ying*

disclose, teach, or suggest that “***potential estimated performance gains comprise a characteristic of a print job,***” and “***installing said selected one or more of the fonts on a print device of the visitor.***”

In this regard, Office alleges that Applicants’ specification provides a non-limiting description of “performance gain” as an increase in performance. The Office concludes that since *Ying* includes a teaching of a “performance gain,” the proposed combination renders Applicants’ claimed method obvious. Applicants disagree. This incomplete construction of Applicants’ claims leads to a failure to consider features required by the Applicants’ claims that are absent from the cited prior art. Missing from *Ying* and *Flowers* is a teaching of Applicants’ claimed “***potential estimated performance gains comprise a characteristic of a print job,***” and “***installing said selected one or more of the fonts on a print device of the visitor.***” Because *Ying* and *Flowers* do not disclose, teach, or suggest that potential estimated performance gains comprise a characteristic of a print job and installing said selected one or more fonts on a print device of the visitor, Applicants’ independent claim 16 is allowable.

The proposed combination of *Flowers* and *Ying* fails to describe Applicants’ claimed potential estimated performance gains. *Ying*’s best-match score and test drive pages do not disclose, teach, or suggest Applicant’s method. Graphically presenting a score on a display device derived from a comparison of font attributes and presenting sample text rendered on a display with a user selected font does not disclose, teach, or suggest Applicant’s claimed feature that requires “***potential estimated performance gains comprise a characteristic of a print job.***” Graphically presenting the result of a font comparison analysis does not suggest a potential estimated performance gain associated with a print job. Rendering sample text on a display device also does not suggest a potential estimated performance gain associated with a print job. Furthermore, rendering sample text does not suggest “***installing said selected one or more of the fonts on a print device of the visitor.***” For at least these reasons, the proposed combination fails to disclose, teach, or suggest each method limitation recited in Applicants’ claimed method for distributing print device fonts. Thus, the proposed combination fails to establish a *prima facie* case of obviousness for Applicants’ amended claim 16. Accordingly, independent claim 16 is allowable and the rejection should be withdrawn.

Because independent claim 16 is allowable, as discussed above, dependent claims 26 and 29, which depend from independent claim 16, are also allowable. *See In re Fine,*

supra. Accordingly, Applicants respectfully request that the rejection of claims 16, 26, and 29 be withdrawn.

Applicants' independent claim 17 is directed to a web site for distributing print device fonts. The web site comprises software for ***"displaying potential estimated performance gains which may result from installation of a font not previously selected by the visitor, wherein potential estimated performance gains comprise a characteristic of a print job."***

Applicants respectfully submit that the proposed combination of *Flowers* in view of *Ying* does not render Applicants' claimed web site obvious for at least the reason that neither *Flowers* nor *Ying* disclose, teach, or suggest at least the emphasized limitation of claim 17. Specifically, the proposed combination of *Flowers* and *Ying* fails to disclose, teach, or suggest Applicants' claimed limitation that requires ***"displaying potential estimated performance gains which may result from installation of a font not previously selected by the visitor, wherein potential estimated performance gains comprise a characteristic of a print job."***

In this regard, Office alleges that Applicants' specification provides a non-limiting description of "performance gain" as an increase in performance. The Office concludes that since *Ying* includes a teaching of a "performance gain," the proposed combination renders Applicants' claimed method obvious. Applicants disagree. This incomplete construction of Applicants' claims leads to a failure to consider features required by the Applicants' claims that are absent from the cited prior art. Missing from *Ying* and *Flowers* is a teaching of Applicants' claimed ***"displaying potential estimated performance gains which may result from installation of a font not previously selected by the visitor, wherein potential estimated performance gains comprise a characteristic of a print job."*** Because *Ying* and *Flowers* do not disclose, teach, or suggest displaying potential estimated performance gains which may result from installation of a font not previously selected by the visitor, wherein potential estimated performance gains comprise a characteristic of a print job, Applicants' independent claim 17 is allowable.

The proposed combination of *Flowers* and *Ying* fails to disclose, teach, or suggest Applicants' claimed ***"displaying potential estimated performance gains which may result from installation of a font not previously selected by the visitor."*** Moreover, the proposed combination of *Flowers* and *Ying* fails to disclose, teach, or suggest Applicants' claimed potential estimated performance gains that comprise a characteristic

of a print job. *Ying's* best-match score and test drive pages do not disclose, teach, or suggest Applicant's claimed web site. Graphically presenting a score on a display device derived from a comparison of font attributes and presenting sample text rendered on a display with a user selected font does not disclose, teach, or suggest Applicant's claimed feature that defines potential estimated performance gains as a "***characteristic of a print job.***" Graphically presenting the result of a font comparison analysis does not suggest a potential estimated performance gain associated with a print job. Rendering sample text on a display device also does not suggest a potential estimated performance gain associated with a print job. For at least these reasons, the proposed combination fails to disclose, teach, or suggest each feature recited in Applicants' claimed web site. Thus, the proposed combination fails to establish a *prima facie* case of obviousness in view of claim 17. Accordingly, independent claim 17 is allowable and the rejection should be withdrawn.

Because independent claim 17 is allowable, as discussed above, dependent claims 18 - 22, 27, and 30, which depends from independent claim 17, are also allowable. *See In re Fine, supra.* Accordingly, Applicants respectfully request that the rejection of claims 17 - 22, 27, and 30 be withdrawn.

Prior Art Made of Record


The prior art made of record has been considered, but is not believed to affect the patentability of the presently pending claims.

CONCLUSION

For at least the reasons set forth above, Applicants respectfully submit that pending claims 2 - 22 and 25 - 30 are in condition for allowance. Favorable reconsideration and allowance of the present application and all pending claims are hereby courteously requested. If, in the opinion of the Examiner, a telephonic conference would expedite the examination of this matter, the Examiner is invited to call the undersigned attorney at (770) 933-9500.

Respectfully submitted,

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AUTHORIZATION TO DEBIT DEPOSIT ACCOUNT

It is not believed that extensions of time or fees for net addition of claims are required, beyond those, which may otherwise be provided for in documents accompanying this paper. However, in the event that additional extensions of time are necessary to allow consideration of this paper, such extensions are hereby petitioned under 37 C.F.R. §1.136(a), and any fees required therefor (including fees for net addition of claims) are hereby authorized to be charged to Hewlett-Packard's Deposit Account No. 08-2025.